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In re Application of Kenneth W. Carpenter, et al. Application No. 10/788,747 Filed: February 26, 2004 Attorney Docket No. MEDIV2020-2

DECISION ON PETITION

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed July 8, 2010, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

The application became abandoned for failure to timely file a reply within the meaning of 37 CFR 1.113 to the final Office action of May 20, 2009. The proposed reply required for consideration of a petition to revive must be a Notice of Appeal (and appeal fee required by 37 CFR 41.20(b)(2)), an amendment that *prima facie* places the application in condition for allowance, a Request for Continued Examination (RCE) and submission (37 CFR 1.114), or the filing of a continuing application under 37 CFR 1.53(b). See MPEP 711.03(c)(III)(A)(2). Since the amendment submitted does not *prima facie* place the application in condition for allowance, the reply required must be a Notice of Appeal (and appeal fee), RCE, or the filing of a continuing application under 37 CFR 1.53(b). See Attached Advisory Action.

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(d). Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Director may require additional information. See MPEP 711.03(c)(II)(C) and (D). The instant petition lacks item(s) (1).

Further correspondence with respect to this matter should be addressed as follows:

By Mail:

Mail Stop PETITION

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By hand:

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Randolph Building 401 Dulany Street Alexandria, VA 22314

The centralized facsimile number is (571) 273-8300.

Telephone inquiries concerning this decision should be directed to the undersigned at

(571) 272-3213.

Cheryl Gibson-Baylor
Petitions Examiner
Office of Petitions

Enclosure: Advisory Action

Advisory Action Before the Filing of an Appeal Brief

Application No.	Applicant(s)		
10/788,747	CARPENTER ET AL.		
Examiner	Art Unit		
CARALYNNE HELM	1615		

	CARALYNNE HELM	1615	•		
The MAILING DATE of this communication appe	ars on the cover sheet with the c	orrespondence add	ress		
THE REPLY FILED 08 July 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.					
 The reply was filed after a final rejection, but prior to or on application, applicant must timely file one of the following application in condition for allowance; (2) a Notice of Appe for Continued Examination (RCE) in compliance with 37 C periods: 	the same day as filing a Notice of A replies: (1) an amendment, affidavited al (with appeal fee) in compliance	Appeal. To avoid abar t, or other evidence, w with 37 CFR 41.31; or	which places the (3) a Request		
a) \boxtimes The period for reply expires 3 months from the mailing date	of the final rejection.				
b) The period for reply expires on: (1) the mailing date of this A no event, however, will the statutory period for reply expire to Examiner Note: If box 1 is checked, check either box (a) or (ater than SIX MONTHS from the mailing b). ONLY CHECK BOX (b) WHEN THE	g date of the final rejection	on.		
MONTHS OF THE FINAL REJECTION. See MPEP 706.07(•				
Extensions of time may be obtained under 37 CFR 1.136(a). The date have been filed is the date for purposes of determining the period of ext under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the s set forth in (b) above, if checked. Any reply received by the Office later may reduce any earned patent term adjustment. See 37 CFR 1.704(b). NOTICE OF APPEAL	ension and the corresponding amount on hortened statutory period for reply origing than three months after the mailing date	of the fee. The appropria nally set in the final Office	ate extension fee e action; or (2) as		
2. The Notice of Appeal was filed on A brief in comp	liance with 37 CFR 41 37 must be f	filed within two months	s of the date of		
filing the Notice of Appeal (37 CFR 41.37(a)), or any exter Notice of Appeal has been filed, any reply must be filed with AMENDMENTS	nsion thereof (37 CFR 41.37(e)), to	avoid dismissal of the			
3. The proposed amendment(s) filed after a final rejection, b	out prior to the date of filing a brief	will not be entered be	Callee		
(a) They raise new issues that would require further consideration and/or search (see NOTE below); (b) They raise the issue of new matter (see NOTE below);					
(c) They are not deemed to place the application in better appeal; and/or			ne issues for		
(d) They present additional claims without canceling a c	corresponding number of finally reje	cted claims.			
NOTE: (See 37 CFR 1.116 and 41.33(a)).		•			
4. The amendments are not in compliance with 37 CFR 1.12		npliant Amendment (F	²TOL-324).		
5. Applicant's reply has overcome the following rejection(s):					
6. Newly proposed or amended claim(s) would be all non-allowable claim(s).		-	_		
7. For purposes of appeal, the proposed amendment(s): a) [how the new or amended claims would be rejected is prov The status of the claim(s) is (or will be) as follows:	_] Will not be entered, or b) 🔯 Will ided below or appended.	be entered and an ex	planation of		
Claim(s) allowed:					
Claim(s) objected to:					
Claim(s) rejected: <u>1-5, 11, 18-19, and 34.</u> Claim(s) withdrawn from consideration:					
AFFIDAVIT OR OTHER EVIDENCE					
8. The affidavit or other evidence filed after a final action, but because applicant failed to provide a showing of good and was not earlier presented. See 37 CFR 1.116(e).	sufficient reasons why the affidavi				
9. The affidavit or other evidence filed after the date of filing entered because the affidavit or other evidence failed to or showing a good and sufficient reasons why it is necessary	a Notice of Appeal, but prior to the exercome <u>all</u> rejections under appea	l and/or appellant fails	to provide a		
10. The affidavit or other evidence is entered. An explanation REQUEST FOR RECONSIDERATION/OTHER	•				
11. The request for reconsideration has been considered but	does NOT place the application in	condition for allowand	e because:		
12. ☐ Note the attached Information <i>Disclosure Statement</i> (s). (13. ☑ Other: See Continuation Sheet.	PTO/SB/08) Paper No(s)				
/Caralynne Helm/ Examiner, Art Unit 1615	/Juliet C Switzer/ Primary Examiner, Art U	nit 1634			

U.S. Patent and Trademark Office PTOL-303 (Rev. 08-06)

Continuation of 13. Other: The Office Action mailed included a typographical error in its inclusion of Lang et al. in the statement of rejection made under 35 USC 103(a). In light of the entry of the amendment, the objection to claims 1 and 12-14 is hereby withdrawn and claims 1-5, 11, 18-19, and 34 will stand rejected under 35 USC 103(a) over Chu et al. The amendment imports the limitations of claims 10 and 17 into claim 1. The amendment also corrects the naming of the formula in claim 1 and redundant definition of R3. These changes do not obviate the rejection made over Chu et al.

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Applicants argue that Chu et al. do not teach stents with the polymer as recited in claim 1 with an aminoxyl bioactive agent covalently bound via a 2 to 25 amino acid where the surface hydrophobicity is improved as well as the accessibility of the polymer to enzyme activation and the release profile of the bioactive agent. Chu et al. teach the same polymers instantly claimed as well as the attachment of bioactive agents to these polymers with a 2 to 25 amino acid peptide linker and also exemplify an aminoxyl as a particular bioactive agent to attach to the polymer. They also explicitly teach the polymer/linker/drug as a polymeric film on the surface of a stent. Applicants only provide assertions of their improvements discussed in the arguments and these properties are not claimed. It is noted that the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Moreover, since the Chu et al. teach the same polymer, with the same linker, and the same bioactive agent claimed, they must also have the same properties. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present." This treatment results from In re Spada, which states that, "Products of identical chemical composition can not have mutually exclusive properties." In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). (see MPEP 2112.01) Therefore applicants' arguments are unpersuasive.